

REMARKS

Applicant has carefully reviewed the Application in light of the Office Action mailed December 8, 2008. At the time of the Office Action, Claims 1-5, 25 and 27-34 were pending in the Application and stand rejected. Applicant amends several Independent Claims without prejudice or disclaimer. The amendments to these claims are not the result of any Prior Art reference and, thus, do not narrow the scope of any of the claims. Furthermore, the amendments are not related to patentability issues and only further clarify subject matter already present. All of Applicant's amendments have only been done in order to advance prosecution in this case. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Claim Objections

Claim 34 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 33. Applicant has cancelled claim 34 to address the Examiner's objection.

Section 103 Rejection

The Examiner rejects Claims 1-3, 26-29, and 32-34 under 35 U.S.C. §103(a) as being anticipated by Biebesheimer (hereinafter "*Biebesheimer*") in view of Piersol (hereinafter "*Piersol*"). The Examiner also rejects Claims 4 and 30 as being unpatentable over *Biebesheimer* in view of *Piersol* and in further view of Khan (hereinafter "*Khan*"). The Examiner further rejects Claim 5 and 31 as being unpatentable over *Biebesheimer* in view of *Piersol* and in further view of Microsoft Outlook 2000(c) 1995-2000 (hereinafter "*Outlook*").

Applicant respectfully reminds the Examiner that to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

Second, there must be a reasonable expectation of success. Third, the prior reference (or references when combined) must teach or suggest all of the claim limitations.¹

It is respectfully submitted that the rejected claims are patentable over the art of record based on at least the third criterion of obviousness: none of the references alone or in combination teach, suggest, or disclose each claim limitation of the Independent Claims. For example, with respect to Independent Claim 1, no reference of record provides for "...a search editor view to enable parameters of a search of tags of objects captured by the capture system to be defined, the capture system configured to intercept data from data streams, reconstruct the data, and store network transmitted objects according to *a capture rule that defines which objects are to be captured by the capture system...*" First, no reference actually intercepts data from data streams. Note that *intercept* in such a context connotes accessing the data stream by an entity [i.e., the capture system] for which the data stream was not necessarily intended. Second, no reference reconstructs that same data. At the passages cited by the Examiner for potentially relevant discussions related to these limitations, there is simply nothing that discloses such these capabilities. In addition, no reference includes a capture rule that defines which of the objects should be captured by the capture system. Hence, there is some selectivity in such a system. Again, these important limitations are provided for in Independent Claim 1, but no reference of record includes such elements. Applicant has reviewed *Biebesheimer* and *Piersol* in their respective entireties and finds nothing that would be relevant to such operations.

For at least these reasons, Independent Claims 1 and 27 are easily allowable over the cited references. Additionally, the corresponding dependent claims from these Independent Claims are also patentably distinct for analogous reasons.

It is also worth noting that, even if all elements of the claims were disclosed in various prior art references, which is certainly not the case here as discussed above, the claimed invention taken as a whole still cannot be said to be obvious without some reason why one of ordinary skill at the time of the invention would have been prompted to modify

¹ See M.P.E.P. §2142-43.

the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention.

The controlling case law, rules, and guidelines repeatedly warn against using an applicant's disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, "The tendency to resort to 'hindsight' based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." M.P.E.P. § 2142.

The U.S. Supreme Court's recent decision in *KSR Int'l Co. v. Teleflex, Inc.* reiterated the requirement that Examiners provide an explanation as to why the claimed invention would have been obvious. *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). The analysis regarding an apparent reason to combine the known elements in the fashion claimed in the patent at issue "should be made explicit." *KSR*, 127 S. Ct. at 1740-41. "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.* at 1741 (internal quotations omitted).

The new examination guidelines issued by the United States Patent and Trademark Office ("PTO") in response to the *KSR* decision further emphasize the importance of an explicit, articulated reason why the claimed invention is obvious. Those guidelines state, in part, that "[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit." *Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision In KSR International Co. v. Teleflex Inc.*, 72 Fed. Reg. 57526, 57528-29 (Oct. 10, 2007) (internal citations omitted).

For at least these reasons, all of the pending claims have been shown to be allowable as they are patentable over the references of record. Notice to this effect is respectfully requested in the form of a full allowance of these claims.

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CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

The large entity fee of \$810 for filing this Request for Continued Examination is being paid concurrently herewith via the attached Credit Card Payment Form (PTO-2038).

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact Thomas J. Frame at (214) 823-1241.

Respectfully submitted,

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